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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,417	02/03/2005	Rainer Blum	264738US0PCT	1181

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C. IRVIN MCCLELLAND
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

CORDRAY, DENNIS R

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/523,417

Applicant(s)

BLUM ET AL.

Examiner

Dennis Cordray

Art Unit

1731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-10.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


ERIC HUG
PRIMARY EXAMINER

Continuation of 11. Applicant's arguments filed 9/29/2006 have been fully considered but they are not persuasive. Applicant argues on p 2 that Kuo's recitation (col 10, lines 49-53) of "Typically, both components are added close to the headbox prior to sheet formation" is not synonymous with addition "after the last shearing stage", although Applicant admits that it could be after the last shearing stage. Thus, Applicant concedes that, in some embodiments of Kuo et al, the cationic polymer and microparticle retention aids of Kuo et al are added after the last shearing stage before a head box.

Applicant argues in the footnote at the bottom of p 2 that the use of Lamar et al and Small et al should have been included in the statement of rejection. The references were only used to respond to Applicant's previous arguments and to demonstrate that "close to the headbox" has been known in prior art to refer to "after the last shearing stage". The references were neither used in nor relied upon to support the rejection.

Applicant argues on pp 3-5 that the disclosure of Kuo et al does not contain "sufficient specificity" to anticipate the instant invention and that "picking and choosing" had to occur to arrive at the instant invention. Kuo et al discloses embodiments that overlap every feature of the rejected claims. The following is a quotation of MPEP 2131.03:

2131.03 [R-2] Anticipation of Ranges

II. PRIOR ART WHICH TEACHES A RANGE WITHIN, OVERLAPPING, OR TOUCHING THE CLAIMED RANGE ANTICIPATES IF THE PRIOR ART RANGE DISCLOSES THE CLAIMED RANGE WITH "SUFFICIENT SPECIFICITY"

When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims.

The range disclosed by Kuo et al for the molecular weight of the cationic polymer is narrower than the claimed range in the instant invention and approximately 87.5% of Kuo's range overlaps the claimed range. There can be no question of sufficient specificity in the molecular weight range disclosed by Kuo et al. Regarding the point of addition for the retention aid, Applicant argues that no investigation was made by Kuo et al of any criticality regarding at what specific stage in the papermaking process it is added. Kuo et al indicates that the best results are achieved when the copolymer is added to the thin stock and the microparticle is added thereafter (col 10, lines 49-53). Kuo et al then recites that "Typically, both components are added close to the headbox prior to sheet formation", thus clearly indicating a preference. As discussed above, "close to the headbox" has been understood in the prior art to refer to after the last shearing stage. It is the Examiner's contention that this point of addition is taught with sufficient specificity to be anticipatory. Regarding the claimed charge density, approximately 13% of the range of charge density (1-24 meq/g) disclosed by Kuo et al overlaps the claimed range of 0-4 meq/g. It is the Examiner's opinion that this overlap discloses the claimed range with sufficient specificity for anticipation.

With regard to showing "surprising results," Applicant refers to the superior results obtained using the instant invention. The examples recite differences obtained with different addition sequences as follows:

Examples 1 and 2, presumably from the invention - adding the cationic polymer and the bentonite microparticle retention aid after the screen, which from the description is assumed to be the last shear stage, but before the headbox.

Comparative Examples 1 and 2, presumably from prior art - adding the cationic polymer before the screen and the bentonite microparticle retention aid after the screen but before the headbox.

The point of addition of the instant invention has been discussed above and is anticipated by Kuo et al. No data are given to support surprising results when using cationic polymers having either the claimed charge density or the claimed molecular weight versus the disclosure of the nearest prior art Kuo et al. The only cationic polymer used is a commercially available polyacrylamide. Thus no evidence of surprising results have been provided to indicate that the disclosure of Kuo et al is not anticipatory.

With regard to the argument on p 6 that neither Zhang et al nor Kuo et al are identical or substantially identical in structure or composition vis-vis the claimed process, Kuo et al does disclose the same composition or structure as discussed above. In addition, the combination of Zhang et al in view of Kuo et al also results in substantially the same composition and structure as the claimed process and thus in the claimed properties of that composition.

The rejections are maintained.